

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

CALABRIA ET AL. Confirmation No. 7681

Application No.: 10/743,520 Examiner: SORKOWITZ

Filed: DECEMBER 19, 2003 Docket No.: D/A3360Q1USNP  
XERZ 200688US01

Title: SERVER-BASED KEYWORD ADVERTISEMENT MANAGEMENT

APPELLANTS' REPLY BRIEF

Appeal from Group 3622

Alan C. Brandt, Esq., Reg. No. 50,218  
FAY SHARPE LLP  
The Halle Building – 5th Floor  
1228 Euclid Avenue  
Cleveland, OH 44115  
Phone: 216-363-9000  
E-mail: [a.brandt@faysharpe.com](mailto:a.brandt@faysharpe.com)  
Attorneys for Appellants

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being transmitted to the USPTO by electronic transmission via the EFS Web on the date indicated below.

22 July 2011

Date

Alan C. Brandt

Name:

I. ARGUMENT

Appellants have reviewed the Examiner's Answer mailed May 24, 2011. This Appellants' Reply Brief is submitted in response to the Examiner's Answer. The Grounds for Rejection (see Sec. 9, pp. 3-25) laid out in the Examiner's Answer is merely a recitation of the prior Office Action and has been addressed in the Appellants' Brief on Appeal filed April 22, 2011. Certain points from the Response to Argument (see Sec. 10, pp. 26-41) of the Examiner's Answer are addressed below.

A. Rejection of Claims 1-21, 23-52, 55, 56, and 58-60 under  
§ 101

Supplemental arguments against the § 101 rejections of independent claims 1, 40, and 42 are provided in the following paragraphs.

1. Independent Claims 1, 40 and 42 are Directed to Statutory Processes

In Section 10 of the Answer (see pg. 32), the Examiner argues "automatically" can be interpreted to mean a human being by rote memory, as a "system" is not mandated to be hardware. As to method claims 1, 40, and 42, the Examiner appears to simply pull the term "automatically" out of the claims and allege that "automatically submitting the optimized bid" could be performed by a human being by rote memory. The Appellants respectfully disagree. The Examiner's argument does not interpret the term "automatically" in the context of the corresponding claim or even the corresponding element of the claim. The Appellants submit that "automatically submitting the optimized bid" in the context of the corresponding claims inherently requires a computer or a processor to be performed.

In Section 10 of the Answer (see pg. 32), the Examiner argues further that each step of method claims 1, 40, and 42 can be performed by a human being, such as optimizing a bid using an abacus. First, this statement is contradictory because an abacus is a structural component (i.e., hardware). Moreover, performing "optimizing a bid" using an abacus, as suggested by the Examiner, is an example of how the

“optimizing” element of the corresponding claims could be tied to a machine rather than a reason for rejection of the corresponding claims under § 101.

In Section 10 of the Answer (see pg. 32), the Examiner also states that “statutory transformation, without a tie to a particular machine, is not mandated in the instant claims, as bids are written down and changed on a piece of paper or in a database.” First, this statement is not consistent with the “machine or transformation” test. The “OR” language in the “machine or transformation” test provides that a method claim is directed to a statutory process if it is either 1) tied to a particular machine or apparatus OR 2) transforms an underlying subject matter to a different state or thing. Moreover, writing a bid and changing a bid on paper or in a database, as suggested by the Examiner, is an example of how a bid could be transformed from an original bid to a revised bid rather than a reason for rejection of the corresponding claims under § 101.

In view of the foregoing supplemental arguments and previous arguments presented on Appeal, the Appellants respectfully request that the § 101 rejections of claims 1, 40, and 42 be withdrawn.

B. Rejection of Claims 40 and 41 under § 102

Supplemental arguments against the § 102(e) rejections of independent claim 40 over Skinner are provided in the following paragraphs.

1. Independent Claim 40 Patentably Distinguishes Over Skinner

In Section 10 of the Answer (see pp. 32-34 & 39), the Examiner argues the term “advertisement” includes a keyword displayed by a search engine, such as Google and Yahoo. The Examiner further argues it makes no difference whether an advertisement is negative or positive. For example, the Examiner asserts the keyword “IBM computer” could be positive, negative, or neutral and still be an advertisement for “IBM computer”. As another example, the Examiner asserts the keyword “horrible IBM computer,” while appearing negative, is an advertisement and might attract customers or might be good advertising for IBM’s competitors. The Appellants respectfully disagree. An advertisement is a promotional or persuasive public notice with respect to a

corresponding advertiser. Material that is negative to the advertiser is not an advertisement for that advertiser. For example, “horrible IBM computer” is not an advertisement for IBM. The Examiner’s assertion that it does not matter whether an advertisement is positive or negative fails to consider that this distinction with respect to an advertiser as recited in the claim (i.e., candidate advertisement associated with the advertiser). Hence, the Examiner’s assertion that “horrible IBM computer” is negative, but still an advertisement for IBM’s competitors has no relationship in the context of the claim. Separately, the Examiner’s assertion is contractor because “horrible IBM computer” is not negative with respect to IBM’s competitors.

In Section 10 of the Answer (see pp. 30, 34 & 39), the Examiner argues paragraphs 44-60 of Skinner teach the calculation of an optimized bid for each advertisement-publisher web page pair created based at least in part on the corresponding ROAS. The Appellants respectfully disagree. The cited portions of Skinner merely disclose how advertisers may place bids for auctioned positions in a search results list and how a maximum bid for the auctioned positions might be determined for the advertisers. Notably, Skinner does not refer to the maximum bid as an optimized bid for an advertisement-publisher web page pair as recited in element f).

In Section 10 of the Answer (see pg. 30 & 39), the Examiner argues that placing an advertiser’s search listing linked to a website in a search results list is an advertisement-publisher website pair. According to the Examiner, a link is a pairing. Further, the Examiner asserts a web link to a website, such as a button to click that says “IBM,” is also an advertisement for the website. The Appellants respectfully disagree. As noted above, an advertisement is promotional or persuasive with respect to a corresponding advertiser. A link or button merely reciting an advertiser’s name is not promotional or persuasive. Further, the pair to which claim 40 relates is an advertisement-publisher website pair. A link to a website of a search result entry is not going to be to the publisher since a publisher is most analogous to the search engine of Skinner. In other words, search result entries from the search engine are not going to contain links to the search engine.

In view of the foregoing supplemental arguments and previous arguments presented on Appeal, the Appellants respectfully submit that independent claim 40 is patentably distinguished from Skinner.

C. Rejection of Claims 1-21, 23-30, 55, 56, 58, and 59 under  
§ 103

Supplemental arguments against the § 103(a) rejections of independent claim 1 and dependent claims 8 and 9 over the combination of Skinner and Paine are provided in the following paragraphs.

1. Independent Claim 1 Patentably Distinguishes Over the Combination of Skinner and Paine

In Section 10 of the Answer (see pg. 35 & 39), the Examiner argues the term “advertisement” includes a keyword displayed by a search engine, such as Google and Yahoo. The Examiner further argues it makes no difference whether an advertisement is negative or positive. For example, the Examiner asserts the keyword “horrible IBM computer,” while appearing negative, is an advertisement and might attract customers or might be good advertising for IBM’s competitors. The Appellants respectfully disagree. As discussed above in the rebuttal arguments distinguishing claim 40 from Skinner, an advertisement is promotional or persuasive public notice with respect to a corresponding advertiser. The Examiner is ignoring that whether public notice is positive or negative is assessed with respect to a corresponding advertiser as recited in the claim (i.e., candidate advertisement associated with the advertiser).

In Section 10 of the Answer (see pg. 36 & 39), the Examiner argues paragraphs 44-60 of Skinner teach the calculation of an optimized bid for each advertisement-publisher web page pair created based at least in part on the corresponding ROAS. The Appellants respectfully disagree. The cited portions of Skinner merely disclose how advertisers may place bids for auctioned positions in a search results list and how a maximum bid for the auctioned positions might be determined for the advertisers. Notably, Skinner does not refer to the maximum bid as an optimized bid for an advertisement-keyword pair as recited in element g).

In Section 10 of the Answer (see pg. 27 & 39), the Examiner argues that placing an advertiser's search listing linked to a website in a search results list is an advertisement-keyword pair. According to the Examiner, a link is a pairing. Further, the Examiner asserts a web link to a website, as in a button to click that say "IBM," is also an advertisement for the website. The Appellants respectfully disagree. An advertisement is promotional or persuasive with respect to a corresponding advertiser. A link or button merely reciting an advertiser's name is not promotional or persuasive.

In view of the foregoing supplemental arguments and previous arguments presented on Appeal, the Appellants respectfully submit that independent claim 1 is patentably distinguished from the combination of Skinner and Paine.

2. Dependent Claim 8 Patentably Distinguishes Over the Combination of Skinner and Paine

In Section 10 of the Answer (see pg. 37), the Examiner asserts Skinner teaches estimating click-through rates for advertisement-keyword pairs calculated by day, month or year. The Examiner further asserts that if the ROAS for an advertisement-keyword pair is not acceptable, the advertisement-keyword pair is removed from use. This, according to the Examiner constitutes a trial. The Examiner further asserts Skinner tracks and uses non ROAS click-through rates and an acceptable number of user action as a measure of relevance of the advertisement. The Appellants respectfully disagree. Skinner is not estimating click-through rates. Rather, Skinner is directly measuring click-through rates. As the Examiner admits, an advertisement-keyword pair is removed from use if ROAS is unacceptable. In view of the foregoing supplemental arguments and previous arguments presented on Appeal, the Appellants respectfully submit that claim 8 is patentably distinguished from the combination of Skinner and Paine.

3. Dependent Claim 9 Patentably Distinguishes Over the Combination of Skinner and Paine

In Section 10 of the Answer (see pg. 37), the Examiner asserts Skinner teaches estimating click-through rates for advertisement-keyword pairs calculated by day, month or year. The Examiner further asserts that if the ROAS for an advertisement-keyword

pair is not acceptable, the advertisement-keyword pair is removed from use. This, according to the Examiner constitutes a trial. The Examiner further asserts Skinner tracks and uses non ROAS click-through rates and an acceptable number of user action as a measure of relevance of the advertisement. The Appellants respectfully disagree. Skinner is not estimating click-through rates. Rather, Skinner is directly measuring click-through rates. As the Examiner admits, an advertisement-keyword pair is removed from use if ROAS is unacceptable. In view of the foregoing supplemental arguments and previous arguments presented on Appeal, the Appellants respectfully submit that claim 9 is patentably distinguished from the combination of Skinner and Paine.

#### D. Rejection of Claim 57 under § 103

Supplemental arguments against the § 103(a) rejection of independent claim 57 over the combination of Skinner and Paine are provided in the following paragraphs.

##### 1. Independent Claim 57 Patentably Distinguishes Over the Combination of Skinner and Paine

In Section 10 of the Answer (see pp. 26 & 39), the Examiner argues the term “advertisement” includes a keyword displayed by a search engine, such as Google and Yahoo, and that it makes no difference whether an advertisement is negative or positive. For example, the Examiner asserts the keyword “horrible IBM computer,” while appearing negative, is an advertisement and might attract customers or might be good advertising for IBM’s competitors. The Appellants respectfully disagree. As discussed above in the rebuttal arguments distinguishing claim 40, an advertisement is promotional or persuasive public notice with respect to a corresponding advertiser. The Examiner is ignoring that whether public notice is positive or negative is assessed with respect to a corresponding advertiser as recited in the claim (i.e., candidate advertisement associated with the advertiser).

In Section 10 of the Answer (see pp. 27 & 39), the Examiner argues that placing an advertiser’s search listing linked to a website in a search results list is an advertisement-keyword pair. According to the Examiner, a link is a pairing. Further, the Examiner asserts a web link to a website, as in a button to click that say “IBM,” is also

an advertisement for the website. The Appellants respectfully disagree. An advertisement is promotional or persuasive with respect to a corresponding advertiser. A link or button merely reciting an advertiser's name is not promotional or persuasive.

In view of the foregoing supplemental arguments and previous arguments presented on Appeal, the Appellants respectfully submit that independent claim 57 is patentably distinguished from the combination of Skinner and Paine.

E. Rejection of Claims 31-39 Under § 103

Supplemental arguments against the § 103(a) rejection of independent claim 31 over the combination of Skinner and Paine are provided in the following paragraphs.

1. Independent Claim 31 Patentably Distinguishes Over the Combination of Skinner and Paine

In Section 10 of the Answer (see pp. 27 & 39), the Examiner argues the term "advertisement" includes a keyword displayed by a search engine, such as Google and Yahoo. The Examiner further argues that it makes no difference whether an advertisement is negative or positive. For example, the Examiner asserts the keyword "horrible IBM computer," while appearing negative, is an advertisement and might attract customers or might be good advertising for IBM's competitors. The Appellants respectfully disagree. As discussed above in the rebuttal arguments distinguishing claim 40, an advertisement is promotional or persuasive public notice with respect to a corresponding advertiser. The Examiner is ignoring that whether public notice is positive or negative is assessed with respect to a corresponding advertiser as recited in the claim (i.e., candidate advertisement associated with the advertiser).

In Section 10 of the Answer (see pg. 28 & 39), the Examiner argues paragraphs 44-60 of Skinner teach the calculation of an optimized bid for each advertisement-publisher web page pair created based at least in part on the corresponding ROAS. The Appellants respectfully disagree. The cited portions of Skinner merely disclose how advertisers may place bids for auctioned positions in a search results list and how a maximum bid for the auctions position might be determined for the advertiser. Notably,

Skinner does not refer to the maximum bid as an optimized bid for an advertisement-keyword pair as recited in the bid determination system of claim 31.

In view of the foregoing supplemental arguments and previous arguments presented on Appeal, the Appellants respectfully submit that independent claim 31 is patentably distinguished from the combination of Skinner and Paine.

F. Rejection of Claims 42-52 Under § 103

Supplemental arguments against the § 103(a) rejections of independent claim 42 and dependent claims 44 and 52 over the combination of Skinner and Paine are provided in the following paragraphs.

1. Independent Claim 42 Patentably Distinguishes Over the Combination of Skinner and Paine

In Section 10 of the Answer (see pg. 32-34), the Examiner argues advertisement includes a keyword displayed by a search engine, such as Google and Yahoo, and that it makes no difference whether an advertisement is negative or positive. For example, the Examiner asserts the keyword “horrible IBM computer,” while appearing negative, is an advertisement and might attract customers or might be good advertising for IBM’s competitors. The Appellants respectfully disagree. As discussed in connection with claim 40, an advertisement is promotional or persuasive public notice with respect to a corresponding advertiser. The Examiner is ignoring that whether public notice is positive or negative is assessed with respect to a corresponding advertiser as recited in the claim (i.e., candidate advertisement associated with the advertiser).

In Section 10 of the Answer (see pg. 31), the Examiner argues that placing an advertiser’s search listing linked to a website in a search results list is an advertisement-keyword pair. According to the Examiner, a link is a pairing. Further, the Examiner asserts a web link, as in a button to click that say “IBM,” to a website is also an advertisement for the website. The Appellants respectfully disagree. An advertisement is promotional or persuasive with respect to a corresponding advertiser. A link or button merely reciting an advertiser’s name is not promotional or persuasive.

In view of the foregoing supplemental arguments and previous arguments presented on Appeal, the Appellants respectfully submit that independent claim 42 is patentably distinguished from the combination of Skinner and Paine.

**2. Dependent Claim 44 Patentably Distinguishes Over the Combination of Skinner and Paine**

In Section 10 of the Answer (see pg. 40), the Examiner argues Paine discloses candidate advertisements selected for placement in search results lists based at least in part on information from the advertiser, such as search terms and web pages, and relies upon paragraph 13 of Paine. The Appellants respectfully disagree. The cited portions of Paine merely disclose how a database of search terms relating to an advertiser's service or product is maintained using certain criteria relating to the search term's effectiveness (e.g., impressions, clicks, click-through rates, and sales). Notably, Paine does not disclose that advertisements (i.e., search result entries) are selected from information maintained in the database.

In Section 10 of the Answer (see pg. 40), the Examiner further argues the limitation of "maintaining the database" is not required by claim 44. However, the Appellants are not arguing such a limitation is required. Rather, Appellants merely point out the referenced portions concern a database containing search terms, which the Examiner is analogizing to the claimed keywords, and do not disclose that the search terms in the database are matched to content in search result entries (i.e., advertisements) to create a search results list.

In view of the foregoing supplemental arguments and previous arguments presented on Appeal, the Appellants respectfully submit that claim 44 is patentably distinguished from the combination of Skinner and Paine.

**3. Dependent Claim 52 Patentably Distinguishes Over the Combination of Skinner and Paine**

In Section 10 of the Answer (see pg. 41), the Examiner notes a system logs into the advertiser's online marketing media (OMM) account to determine competitors bid amounts, as well as other competitor bid information, such as ranking, URL, and cost

per click of the competitor. The information, the Examiner asserts, can be employed for bidding. The Appellants respectfully disagree. The OMM is not a competitor website. Further, a URL to a competitor website does not mean information from the URL is employed for bidding. The URL may, for example, merely be employed to identify the competitor in other databases. In view of the foregoing supplemental arguments and previous arguments presented on Appeal, the Appellants respectfully submit that claim 52 is patentably distinguished from the combination of Skinner and Paine.

CONCLUSION

For all of the reasons stated in the Appellants' Brief on Appeal and for the additional reasons discussed above, it is respectfully submitted that the rejections of the currently-pending claims are in error and that all claims (claims 1-21, 23-52 and 55-60) are currently in condition for allowance. Accordingly, Appellants respectfully request this Honorable Board to reverse the rejections of the claims.

Date: July 22, 2011

Respectfully submitted,

  
Alan C. Brandt  
Registration No. 50,218

FAY SHARPE LLP  
The Halle Building – 5th Floor  
1228 Euclid Avenue  
Cleveland, OH 44115  
Phone: 216-363-9000  
E-mail: [abrandt@faysharpe.com](mailto:abrandt@faysharpe.com)